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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,432	08/01/2001	John M. Cuckler	10557/247605	6380

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EXAMINER

WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,432

Applicant(s)

CUCKLER ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-22, 67-69, 71, 73 and 74 is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-13, 23-36, 38, 41, 42, 47, 49, 51, 53, 56, 57, 59, 61, 63, 66, and 76 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1,3-8,10-38,41,42,47,49,51,53,56,57,59,61,63,66-69,71,73,74 and 76.

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The English translation of FR 2 660 546 A was received on December 27, 2004, and is hereby incorporated as part of the Applicant's Response to the final Office action mailed on July 23, 2004.

The Amendment fails to comply with 37 CFR § 1.173 in that there are certain inaccuracies as to added or deleted language. In claim 11, line 2, "extends" should be underlined. In claim 12, line 2, "of the" should be underlined. In claim 13, line 22, --in-- should be inserted after "position". In claim 35, line 12, --distally-- should be inserted after "extends".

Claims 1, 3-8, and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 21, "the wall" is indefinite as to which of the walls (claim 1, lines 2 and 10) is being referenced. A similar error occurs in claim 13.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 35, 36, 38, 41, 42, 47, 49, 51, 53, 56, 57, 59, 61, 63, 66, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balay et al., FR 2 660 546 A. The cup member is seen as comprising the cup assembly 4 *and* the hemispherical insert 5. Regarding claim 35 and others, the cup member includes a rim defined by the annular lip 26; Figures 1 and 2 illustrate a superior flange 9, a posterior flange 10, and an inferior flange 8. An inner concave surface (of the hemispherical insert 5) extends distally from the rim plate 26 to a greater extent adjacent the superior and posterior flanges 9 and 10 (Figure 3). To form another opening 20 in the inferior flange 8 would have been obvious in order to supplement the fixation and to help reduce rotational micro-movements. Regarding claim 47, the cup member also has an inner concave surface (of the cup assembly 4) adapted to receive liner 5. Regarding claim 56 and others, at least one of the concave surfaces is *capable* of receiving a cemented liner, whether or not such was the intent.

It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense (*In re Hutchison*, 69 USPQ 138). MPEP 2106, section II. C., explains that language which suggests or makes optional but “does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”; “examples of

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language that may raise a question as to the limiting effect of the language in a claim” are “adapted to” and “adapted for” clauses.

Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Hermann et al., EP 0 663 193 A1, which discloses a buttress 4 mounted on the distal side (e.g., Figures 2c, 5b, and 6b) at the lower surface of the flange portion 2a and extending downwardly from the flange portion (Figure 1).

Claims 24-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hermann et al., EP 0 663 193 A1. Thicknesses within the range set forth in instant claim 24 were well known in the art and would have been obvious in order to balance physical characteristics pertaining to strength, weight, and so on. Bone screws and reinforced screw holes in acetabular cups were likewise common in the art and would have been obvious in order to improve the anchorage and durability of the implant, the assembly being implanted without the use of bone cement (Derwent abstract, last two lines).

Claims 1, 3-8, and 10-13 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-22, 67-69, 71, 73, and 74 are allowable over the prior art.

The Applicant's remarks have been considered. With regard to the Hermann et al. document, the term “bone cement” is nowhere to be found in the language of the Applicant's claims 23-34. The definition of “buttress” is “[s]omething that supports or reinforces”

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(*Webster's II New Riverside University Dictionary*, 1984). The Hermann et al. holding unit 4 clearly supports the inner shell 3 and reinforces the overall structure of the implant. Moreover, “[i]t is applicant’s duty to precisely define the invention, and not the [examiner’s]” (*In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997)); attention is directed to MPEP § 2111.01. As for Balay et al., the Applicant likewise does not provide a definition of “cup member” (in a manner prescribed in MPEP § 2111.01) such that its scope somehow excludes the Balay et al. cup assembly 4 combined with the hemispherical insert 5. The examiner agrees with the Applicant that the “hemispherical insert 5 is a polyethylene insert” (Applicant’s Response of December 23, 2004: page 22, lines 6-7) but fails to see why a cup member with a liner or cup shaped insert cannot (collectively) be viewed as a cup member. The Applicant discusses a buttress, but the claims rejected on the basis of Balay et al. lack any mention of such a term.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (571) 272-4762. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
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